

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner took the following actions:

1. objected to the title;
2. rejected claims 1-19, 22, and 23 under 35 U.S.C. § 112, second paragraph;
3. rejected claims 24 and 25 under 35 U.S.C. § 101;
4. rejected claims 1-4, 6, 7, 9-11, 13-15, and 22-25 under 35 U.S.C. § 102(a) as being anticipated by Japanese Patent Publication 2004-318923 A (hereafter "*Shimizu*");
5. rejected claims 20 and 21 under 35 U.S.C. § 102(b) as being anticipated by US Patent Publication 2002/0012304 (hereafter "*Nakahara*");
6. rejected claims 5 and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Shimizu* in view of Japanese Patent Publication 2004-120035 (hereafter "*Kamio*");
7. rejected claim 1-6, 9-14, 17-19, and 22-25 under 35 U.S.C. § 103(a) as being unpatentable over *Nakahara* in view of US Patent Publication 2003/0147629 (hereafter "*Kikuchi*"); and
8. rejected claims 7, 8, 15, and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Nakahara* in view of *Kikuchi*, and further in view of *Shimizu*.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

By this amendment, Applicants amend claims 1-3, 6-9, and 13-25. Claims 1 - 25 are currently pending.

**I. The Objection to the Title of the Invention**

The Office Action objected to the title of the invention and stated that “[t]he title of the invention is not description” (Office Action at page 2). Applicants respectfully disagree with the Examiner’s objection. Nevertheless, Applicants have amended the title to overcome the objection, and respectfully request that the Examiner withdraw the objection.

**II. The Rejection of Claims 1-19, 22, and 23 under 35 U.S.C. § 112, second paragraph**

The Office Action states that claim 1-19, 22, and 23 are “indefinite for failing to particularly point out and distinctly claim the subject matter” in claim 1, line 5, “the phrase ‘which makes matching’ is indefinite because it is unclear, .... Similar clarification is needed in line 5 of claim 2, line 12 of claim 9, line 5 of claim 22 and line 12 of claim 23” (Office Action at page 2). Applicants respectfully disagree with the Examiner’s rejection. Nevertheless, Applicants have amended claim 1 to replace “which makes matching for additionally-recorded data performed” with “configured to update the predetermined menu based on additionally-recorded data.” Similar amendments are made to claims 2, 9, 22, and 23. Claims 3-8 and claims 10-19 depend from claim 2 and claim 9 respectively, and were rejected due to this dependency. The claims are sufficiently definite and in compliance with 35 U.S.C. § 112, second paragraph. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection.

**III. The Rejection of Claims 24 and 25 under 35 U.S.C. § 101**

The Office Action states that claims 24 and 25 that are directed to a computer program are rejected "because the claimed invention is directed to non-statutory subject matter" (Office Action at Page 3). Applicants respectfully disagree with the Examiner's rejection. Nevertheless, Applicants have amended claims 24 and 25 to "[a] non-transitory computer-readable medium comprising instructions executable by a computer processor to implement a method for image recording control." The amended claims are directed to statutory subject matter. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection.

**IV. The Rejection of Claims 1-4, 6, 7, 9-11, 13-15, and 22-25 under 35 U.S.C. § 102(a)**

The Examiner rejected claims 1-4, 6, 7, 9-11, 13-15, and 22-25 as being anticipated by *Shimizu* (Office Action at page 3). Applicants respectfully request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 102(a) for at least the reasons discussed below.

Independent claim 1 recites an image-recording device comprising, among other things, "additional recording-mode control unit configured to set a mode for indicating whether additional recording onto the inserted disk is allowed."

*Shimizu* discloses "a DVD+RW recorder wherein a redundant operation time is reduced" (*Shimizu*, abstract (machine translation)). The DVD+RW recorder can be "equipped with a DVD+RW disk" (*Shimizu*, paragraph [0064]-[0078]). The DVD+RW recorder has a system controller 26, which "reads each management data about the contents data currently recorded on the DVD+RW disk ..., and stores it in an internal

memory” when the DVD+RW recorder is “equipped with a DVD+RW disk” (*Shimizu*, paragraph [0066] (machine translation)). When the system controller 26 performs emission control of a disk, “it writes the contents of each management data which writes in first VMGM\_VOBS44 which is menu data, then is stored in the internal memory just before the discharge” (*Shimizu*, paragraph [0072] (machine translation)).

However, *Shimizu* does not disclose or even suggest “additional recording-mode control unit configured to set a mode for indicating whether additional recording onto the inserted disk is allowed” as recited by independent claim 1. *Shimizu* merely discloses writing “the contents of each management data which writes in first VMGM\_VOBS44 which is menu data ... just before the discharge” (*Shimizu*, paragraph [0072] (machine translation)). Therefore, *Shimizu* fails to teach, or even suggest, “additional recording-mode control unit configured to set a mode for indicating whether additional recording onto the inserted disk is allowed” as recited by claim 1. Accordingly, it is respectfully submitted that *Shimizu* does not anticipate claim 1.

Although of different scope than claim 1, independent claims 2, 9, 22, 23, 24 and 25 includes similar features, and are distinguishable from *Shimizu* for at least similar reasons as discussed above with respect to claim 1. Claims 3, 4, 6, and 7 depend from claim 2, and claims 10-11 and 13-15 depend from claim 9. These dependent claims are allowable at least due to their dependence from allowable base claim.

Accordingly, Applicant respectfully request withdrawal of the rejection of claims 1-4, 6, 7, 9-11, 13-15, and 22-25 under 35 U.S.C. § 102(a), and the allowance of these claims.

**V. The Rejection of Claims 20 and 21 under 35 U.S.C. § 102(b)**

The Examiner rejected claims 20 and 21 under 35 U.S.C. § 102(b) as being anticipated by *Nakahara* (Office Action at page 3-4). Applicants respectfully request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 102(b) for at least the reasons discussed below.

Independent claim 20 recites an image-recording device comprising, among other things, “additional recording-mode control unit configured to set a mode for indicating whether additional recording onto the inserted disk is allowed.”

*Nakahara* discloses “an information editing apparatus for editing recording information already recorded on a write-one recording medium such as DVD-R” (*Nakahara*, abstract). The information editing apparatus determines “whether the optical disk is the DVD-RW or not” (*Nakahara*, Col. 11, lines 60-65). When the loaded optical disk is in “an abnormal state such that a deformed optical disk or an optical disk which has a large blemish and cannot be reproduced ..., the optical disk is rejected to the outside of the information recording/reproducing apparatus” (*Nakahara*, Col. 11, lines 37-47).

However, *Nakahara* does not disclose or even suggest “additional recording-mode control unit configured to set a mode for indicating whether additional recording onto the inserted disk is allowed” as recited by claim 20. *Nakahara* merely discloses rejecting the optical disk “to the outside of the information recording/reproducing apparatus” when the loaded optical disk is in “an abnormal state” (*Nakahara*, Col. 11, lines 37-47). Therefore, *Nakahara* fails to teach, or even suggest, “additional recording-mode control unit configured to set a mode for indicating whether additional

recording onto the inserted disk is allowed” as recited by claim 20. Claim 21 depends from claim 20 and is therefore allowable at least due to its dependence from the allowable base claim.

Accordingly, it is respectfully submitted that *Nakahara* does not anticipate claim 20 and 21. Applicant respectfully request withdrawal of the rejection of claims 20 and 21 under 35 U.S.C. § 102(b), and the allowance of these claims.

**VI. The Rejections of Claims 1-19 and 22-25 under 35 U.S.C. § 103(a)**

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-19 and 22-25 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to any of these claims.

The Examiner rejected claims 5 and 12 as being unpatentable over *Shimizu* and further in view of *Kamio* (Office Action at page 4).

As stated above, *Shimizu* does not disclose or suggest “additional recording-mode control unit configured to set a mode for indicating whether additional recording onto the inserted disk is allowed” as recited by independent claim 1. Although of different scope, independent claims 2 and 9 include similar features and are distinguishable from *Shimizu* for at least similar reason as claim 1. Claim 5 and 12 depend from claim 2 and claim 9 respectively, and therefore distinguishable from *Shimizu* for at least similar reason as claim 2 and claim 9.

*Kamio* discloses an image record regenerative apparatus to “display information in a menu form on a recording medium by superimposing a graphic on already recorded video information” (*Kamio*, Abstract (machine translation)). The Office Action alleges to “agree with the position set forth in written opinion, submitted by applicant for

consideration on 4/20/2007” (Office Action at page 4), which states that the apparatus in *Kamio* “has feedback paths provided between MPEG encoder and MPEG decoder, graphic processing unit, to superimpose processed graphics on output image” (written opinion of Jan. 22, 2007 from Danish Patent and Trademark Office at page 6). Even assuming this is correct, which Applicants do not concede, *Kamio* still does not teach or suggest an “additional recording-mode control unit configured to set a mode for indicating whether additional recording onto the inserted disk is allowed” as recited by independent claim 1 or the similar features of independent claims 2 and 9.

Therefore, claims 2 and 9 are allowable over the cited references. Claim 5 and 12 depend from claim 2 and claim 9 respectively, and are therefore allowable at least due to their dependence from the allowable independent claims, as well as for their own distinguishing features.

The Examiner rejected claims 1-6, 9-14, 17-19, and 22-25 as being unpatentable over *Nakahara* in view of *Kikuchi* (Office Action at page 5-9).

As stated above, *Nakahara* does not disclose or suggest “additional recording-mode control unit configured to set a mode for indicating whether additional recording onto the inserted disk is allowed” as recited by claim 1. Although of different scope, independent claims 2, 9, 22, 23, 24, and 25 include similar features and are distinguishable from *Nakahara* for at least similar reason as claim 1.

*Kikuchi* discloses “a system for recording/playing back video data together with control information” (*Kikuchi*, Abstract). The Office Action alleges that *Kikuchi* teaches “to have updated the menu of a DVD+RW type disc when the content of the DVD+RW type disc has been edited so that the content of the menu matches the media content of

the disc” (Office Action at page 5). Even assuming this is correct, which Applicants do not concede, *Kikuchi* still does not teach or suggest “additional recording-mode control unit configured to set a mode for indicating whether additional recording onto the inserted disk is allowed” as recited by claim 1 or the similar features of independent claims 2, 9, 22, 23, 24, and 25.

Therefore, independent claims 1, 2, 9, 22, 23, 24, and 25 are allowable over combinations of the cited references. Claims 3-8 depend from claim 2, and claims 10-19 depend from claim 9. Thus, these dependent claims are allowable at least due to their dependence from allowable base claim, as well as for their own distinguishing features.

The Examiner rejected claims 7, 8, 15, and 16 as being unpatentable over *Nakahara* in view of *Kikuchi*, in further view of *Shimizu* (Office Action at pages 6-8).

As stated above, claims 7-8 and claims 15-16 are allowable over the combination of *Nakahara* and *Kikuchi* at least due to their dependence from independent claims 2 and 9.

*Shimizu* discloses “a DVD+RW recorder wherein a redundant operation time is reduced” (*Shimizu*, abstract (machine translation)). The Office Action alleges that “the advantages of finalizing/rewriting such edited discs at the time of disc ejection was well known in the art given the time and computing power required for such finalizing/rewriting” by noting *Shimizu* (Office Action at page 6). Even assuming this is correct, which Applicants do not concede, *Shimizu* still does not teach or suggest “additional recording-mode control unit configured to set a mode for indicating whether



additional recording onto the inserted disk is allowed” as recited by claim 2 or the similar features of claim 9.

Therefore, independent claims 2 and 9 are allowable over combinations of the cited references. Claims 7 and 8 depend from claim 2, and claims 15 and 16 depend from claim 9. These dependent claims are allowable at least due to their dependence from allowable base claim, as well as for their own distinguishing features.

Accordingly, Applicant respectfully request withdrawal of the rejection of claims 1-19 and 22-25 under 35 U.S.C. § 103(a), and the allowance of these claims.

#### **VII. Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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